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D3M1/0108

EXAMINER	
BAHTA, A	
ART UNIT	PAPER NUMBER
1317	13

DATE MAILED: 01/08/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/372 509

Applicant(s)

Darcy Bister

Examiner

Abraham Bayta

Group Art Unit

1317

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3(three) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/8/97
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3, 7 and 10-31 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 7 and 10-31 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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15. Claims 1-3, 7, 10-31 are before the Examiner. Claims 4-6 and 8-9 have been canceled.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's first submission after final filed on October 08/97 has been entered.

16. The amendment filed 4/22/96 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the photograph print comprising plastic print material, as set forth in claims 21 and 23.

Applicant is required to cancel the new matter in the response to this Office action.

The following is a new grounds of rejection.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travis (USP 4,584,218) in view of Becker et al (USP 4,791,015) or Davey et al (USP 5,162,141).

19. Travis teaches the step of creating a full scale photograph or print of a particular selected design for mounting upon a wall or a shower, bathtub, Jacuzzi or sauna. See column 1, line 60 - column 2, line 7 and column 2, line 50-53 and line 60-64. The article include a photograph with an adhesive backing, for mounting on a substrate or upon a wall. See abstract. Further, the reference teaches in one embodiment, the use of inks which include protective layers. A layer of pressure sensitive adhesive is mounted and secured upon an and overlies the back of the sheet for securing engagement with a wall. See column 1 lines 32-42.

While Travis suggests a special coating moisture proof, such as nitrocellulose lacquer or urethane may be applied to the imprinted sheet to protect the product from damage or scratch, the reference does not teach the notorious well known transparent protective coating such as transparent vinyl coating that prevents injury to the photograph print.

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20. Becker et al teaches a floor tile or wall tile having a vinyl material layer that functions as a wear layer for a flooring product. See column 4, lines 27-33. Similarly, Davey et al discloses that it is known to use a clear film of a vinyl material for a decorative surface product for floors, walls and furniture. See column 3, lines 61-63.

In addition, several patents teach the use of a vinyl material as a protective coating on a substrate. See for example: See Bodrogi (USP 4,804,572) column 2, lines 22-29; Rohrbacker et al (USP 5,304,272) column 5, lines 62-68; Wiley (USP 4,128,688) column 2, lines 65-68 and Taylor et al (USP column 1, lines 35-37).

21. Accordingly, it would have been obvious to one of ordinary skill in the art to use the protective coating from the teaching of Becker et al or Davey et al in Travis in order to protect the photographic printed design from injury.

22. Claims 10-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travis in view of Becker et al or Davey et al as applied above.

23. As discussed above Travis teaches the basic tile comprising a full scale photograph of an object. Further, the reference teaches an adhesive backing with a strippable layer. See abstract. The reference does not specifically mention a transparent protective coating comprising a vinyl. Becker et al or Davey et al teach a floor tile or wall cover incorporating a decorative printed design in which a transparent upper wear surface of a vinyl material is provided.

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a transparent coating of a vinyl material since it was known in the art that such use of transparent coating of vinyl material in manufacturing a floor tile or wall covering would in fact prevent injury or damage to the photographic print or design of the floor tile.

Concerning claim 12: Travis teaches the limitation of the claim i.e. adhesive backing with a strippable layer. See Abstract.

With respect to claim 13 and 14: Travis teaches a full scale photograph of an object. See column 2, line 3.

With respect to claim 15: the limitation of claim 15, i.e. wherein the photograph print has been enlarged sufficiently to create a substantially larger than the full size, full scale simulation of an object is a mere obvious of design choice which would have been obvious to make the image larger than life size for aesthetic reasons.

With respect to claims 24 and 25: the film material is a conventional and commercially available as Kodak film Duraflex RA.

With respect to claims 26 and 27: Again, Travis teaches the basic claimed subject matter of applicant's invention that is a full scale photograph , drawing or print or a photograph of interest including an adhesive backing and strippable layer. (see Abstract) except for the transparent vinyl

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coating. As discussed above Becker et al or Davey et al disclose that it is known to use a vinyl film which would have been obvious to use the vinyl material the secondary references in Travis in order to protect the printed design.

With respect to claims 28-31: The choice of the photograph subject matter, i.e. retail product, company logo, photograph simulation or floor covering or ground terrain is a mere matter of design choice and does not patentably distinguish over the reference.

Other embodiments as disclosed in the dependent claims such as the thickness of the protective coating being about 5 millimeters and the polyester print being about 9 millimeters have been considered. These limitations are considered to be a matter of design choice or an obvious recitation to one having an ordinary skill in the art and are normally selected according to the manufacturer's specification and are not determinative of patentability.


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A facsimile center has been established in Crystal Mall 1. The hours of operations are Monday through Friday, 8:45 AM to 4:45 PM. This new location should be used in all instances when faxing any correspondence to Group 1300. The Patent Examining Fax Center new telecopier number is (703) 305-5436. Use of the new Crystal Mall 1 center will facilitate rapid delivery of materials to the Group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 1989)

Any inquiry concerning this communication should be directed to Abraham Bahta at telephone number (703) 308-4412.

A. Bahta

01/05/97


PATRICK JOSEPH RYAN
Supervisory Patent Examiner
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